

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE A. SWAIN, STANLEY J. PIETRZYKOWSKI, JR.
MARK C. PETROPOULOS and ALAN D. SMITH

Appeal No. 97-1494
Application 08/395,214¹

ON BRIEF

Before FRANKFORT, McQUADE and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 2, 4 through 7, 9, 10, 14 and 19 as amended subsequent to the final rejection in a paper filed May 22, 1996 (Paper No. 7). Claims 15 through 18 stand allowed.

¹Application for patent filed February 27, 1995.

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Claims 3, 8 and 11 through 13, the only other claims remaining in the application, have been objected to by the examiner, apparently as containing allowable subject matter but as being dependent upon a parent claim which has been rejected.

Appellants' invention relates to a chuck assembly for engaging the inner surface of a substrate. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as found in the Appendix to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

LaRue	4,168,073	Sep. 18, 1979
Petralia	5,449,182	Sep. 12, 1995

In addition, this panel of the Board relies upon the following references of record in new grounds of rejection entered infra:²

Phillips et al. (Phillips)	4,770,456	Sep. 13, 1988
Fukawa et al. (Fukawa)	5,282,888	Feb. 01, 1944

² Both of these references were cited by the examiner in the first Office action mailed September 21, 1995 (Paper No. 3).

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Claims 1, 2, 4 through 7, 9, 10 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by LaRue.

Claim 19 stands rejected under 35 U.S.C. §103 as being unpatentable over LaRue in view of Petralia.

The examiner's full statement of the rejections and response to appellants' arguments appears on pages 3 through 7 of the examiner's answer (Paper No. 11, mailed August 23, 1996) and in the communication from the examiner mailed March 18, 1998 (Paper No. 15). Appellants' viewpoints concerning the examiner's rejections of the appealed claims are found in the brief (Paper No. 10, filed June 24, 1996) and in the reply brief (Paper No. 12, filed September 12, 1996).

OPINION

In arriving at our decision in this appeal, we have carefully considered appellants' specification and claims, the applied references, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1, 2, 4 through 7, 9, 10 and 14 under 35 U.S.C. §102(b) as being anticipated by LaRue, we must agree with appellants (brief, pages 3-4) that LaRue fails to disclose or teach a chuck with a partially hollow elastic boot that is stretched, or is stretchable, in the manner required in appellants' claim 1 on appeal. While the chuck element (14) of LaRue is said to be a plastic member (i.e., column 2, lines 52-56, made of polypropylene which has the property of being wear resistant, resilient, strong, and is machinable into the desired configuration), we find no indication that such plastic member is capable of stretching in the manner recited in appellants' claim 1 on appeal. Instead, the plastic member (14) of LaRue is described as including hinge areas or "living" hinges (21, 22, 23) which are said to allow the chuck member to be outwardly deflected upon retraction of the operating rod (16) so as to grip the inner surface of the glass article (T), with the member (14) returning to its initial or pre-actuation configuration/position due to memory built into the polypropylene member (column 4, lines 21-25). There is nothing in LaRue which would indicate to an artisan that the plastic member (14) therein is capable of stretching to decrease its

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cross-sectional dimension and thereby permit insertion of the chuck member into a substrate as set forth in appellants' claim 1. Nor do we see any reason to assume that such a characteristic is inherent in the deflectable plastic member of LaRue. For this reason, we must conclude that appellants' independent claim 1 on appeal is not anticipated by LaRue.

For the same reason as noted above for independent claim 1, it follows that the examiner's rejection of dependent claims 2, 4 through 7, 9, 10 and 14 on appeal under 35 U.S.C. § 102(b) will likewise not be sustained. The § 103 rejection of dependent claim 19 is premised on the same erroneous factual basis as was applied to claim 1 and the additional teachings pointed to by the examiner in Petralia do not overcome the deficiency of LaRue noted above. Accordingly, the examiner's rejection of claim 19 under 35 U.S.C. § 103 will also not be sustained.

However, under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection against certain of the claims on appeal.

Claims 1, 7, 9 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Phillips. Phillips discloses an internal

gripper or chuck assembly wherein such assembly includes a housing (24) having an open end and defining a passageway in communication with the open end; a hollow elastic boot or gripper portion (30) defining an entry hole at the top end thereof, and an inner surface, wherein the boot material is elastic, wherein the boot when stretched decreases in cross-sectional dimension, and wherein the boot engages the housing, whereby the hollow portion of the boot is in communication with the passageway; and a movable, boot stretching member (20, 22) disposed in the passageway and adapted to engage the inner surface of the boot, wherein movement of the stretching member in a direction to stretch the boot decreases the cross-section dimension of the boot, thereby permitting insertion of the boot into the substrate/work piece (13), and wherein movement of the member in the opposite direction increases the cross-sectional dimension of the boot, thereby permitting engagement of the boot against the inner surface of the substrate/work piece (13). See particularly, Figures 2 and 3 of Phillips, column 2, lines 22-28, and claims 1, 2 and 4 thereof.

As for claims 7, 9 and 14, it is apparent from Figures 2 and 3 of Phillips that 1) the boot is of uniform thickness throughout

its length and is uniformly made from a material having the same hardness value throughout the boot, 2) the boot stretching member is coupled to the boot, and 3) the stretching member (20) is a rod.

Claims 1, 2, 7, 9, 14 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fukawa. Fukawa discloses a holding apparatus or chuck assembly wherein such assembly includes a housing (3, 5) having an open end and defining a passageway in communication with the open end; a hollow elastic boot or bag member (4) defining an entry hole at the top end thereof, and an inner surface, wherein the boot material is elastic, wherein the boot when stretched decreases in cross-sectional dimension, and wherein the boot engages the housing, whereby the hollow portion of the boot is in communication with the passageway; and a movable, boot stretching member (10, 6) disposed in the passage-way and adapted to engage the inner surface of the boot, wherein movement of the stretching member in a direction to stretch the boot decreases the cross-section dimension of the boot, thereby permitting insertion of the boot into the substrate/work piece (1), and wherein movement of the member in the opposite direction increases the cross-sectional

dimension of the boot, thereby permitting engagement of the boot against the inner surface of the substrate/work piece (1). See particularly, Figures 1 and 2 of Fukawa, column 3, lines 53-58, and Column 5, lines 4-10 thereof.

As for claims 2, 7, 9 and 14, it is apparent from Figures 1 and 2 of Fukawa that 1) the housing (3, 5) is a hollow tube structure having open ends, (2) the boot is of generally uniform thickness throughout its length and is uniformly made from a material having the same hardness value throughout the boot, 3) the boot stretching member is coupled to the boot, and 4) the stretching member (10) is a rod.

Regarding the requirement of appellants' claim 19 that the boot is "adapted to form a hermetic seal with the inner surface of the substrate," we direct attention to column 4, lines 43-50, wherein such a seal is discussed in Fukawa.

To summarize, we have reversed the examiner's rejection of claims 1, 2, 4 through 7, 9, 10 and 14 under 35 U.S.C. §102(b) as being anticipated by LaRue and the examiner's rejection of claim 19 under 35 U.S.C. §103 based on LaRue and Petralia. However, in

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addition, pursuant to 37 CFR §1.196(b), we have entered new grounds of rejection against claims 1, 7, 9 and 14 as being anticipated by Phillips and claims 1, 2, 7, 9, 14 and 19 as being anticipated by Fukawa.

In accordance with the foregoing, it is clear that the decision of the examiner has been reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED
37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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